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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,536	08/03/2005	Hartmut Grund	263107US0PCT	9701
22850	7590	07/07/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
JACOBSON, MICHELE LYNN				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
07/07/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/518,536

Applicant(s)

GRUND ET AL.

Examiner

MICHELE JACOBSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11, 13 and 16-27 of copending Application No. 10/518542. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scopes of the conflicting claims both encompass a 5 layer tubular film comprised of 4 layers of polyolefin or modified polyolefin with an outer layer of polyamide. The specific polyolefins and polyamides recited in both applications are the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grund U.S. Patent No. 5,612,104 (hereafter referred to as Grund).
3. Grund teaches a five-layer film comprising a 1st and 5th layer of polyamide, a 3rd core layer of polyolefin and a 2nd and 4th adhesive layer between the polyolefin core layer and the polyamide layers. Useful polyamides for the 1st and 5th layer are recited to be at least one aliphatic polyamide and/or at least one aliphatic copolyamide and/or at least one partially aromatic polyamide and/or at least one partially aromatic copolyamide. (Col. 5, lines 3-5) Specifically, the homopolyamides and/or copolyamides are recited to be produced from monomers selected from the group of caprolactam, laurinlactam (Col. 5, line 32), ω -aminoundecanoic acid (Col. 5, lines 29-30), adipic acid, azelaic acid, sebacic acid, decanedicarboxylic acid, dodecanedicarboxylic acid (Col. 5, lines 27-29), terephthalic acid, isophthalic acid (Col. 5 line 67-Col. 6 line 1), tetramethylenediamine, pentamethylenediamine, hexamethylenediamine, octamethylenediamine (Col. 5, lines 23-25), and xylylenediamine (Col. 5, line 53). The thickness of the inner polyamide layer is recited to be from 1-8 μ m and the outer polyamide layer thickness from 10-40 μ m. (Col. 4, lines 50 and 67)

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4. Suitable polymers for the polyolefin core layer are recited to be homopolymers of ethylene or propylene or copolymers of linear α -olefins having 2 to 8 C-atoms, or mixtures of these homopolymers or copolymers with one another. Particularly suitable are polyolefins having melting points of above 120° C., e.g., LLDPE, HDPE, polypropylene homopolymers, as well as polypropylene block copolymers and polypropylene random-copolymers. (Col. 6, lines 12-19) The thickness of the polyolefin core layer is recited to be from 10-30 μm . (Col. 6, line 20)

5. Suitable polyolefins for 2nd and 4th adhesive layers are recited to be modified homo- or copolymers of ethylene and/or propylene, and optionally of further linear α -olefins with 3 to 8 C-atoms having grafted thereon monomers of the group consisting of α,β -unsaturated dicarboxylic acids, such as maleic acid, fumaric acid, itaconic acid or their acid anhydrides, acid esters, acid amides or acid imides. Additionally suitable are copolymers of ethylene or propylene and optionally of further linear α -olefins with 3 to 8 C-atoms having α,β -unsaturated carboxylic acids, such as acrylic acid, methacrylic acid and/or their metallic salts and/or their alkyl esters, or adequate graft polymers of the mentioned monomers on polyolefins. The thickness of the 2nd and 4th polyolefin adhesive layers is recited to be between 4-8 μm . (Col. 6, line 30)

6. The film of the invention is prepared by coextrusion and subsequent biaxial stretching and thermosetting. (Col. 6, lines 55-56) Depending on the temperatures during thermosetting, a shrinkable or non-shrinkable film may be manufactured. (Col. 7, lines 17-19) The thickness of the film of the invention is recited to be from 30-90 μm . (Claim 22) The film of the invention is recited to be useful for packaging sausage.

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7. Grund does not recite a polyolefin film for the inner layer of the tubular film.
8. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have replaced the interior 1st polyamide layer of Grund with a layer of polyolefin selected from the compositions recited to comprise the 2nd and 4th adhesive layers. Polyolefin layers are well known for their heat sealing properties in the packaging art (see for example US 5021510 or US 5759648) and replacing the polyamide layer with a polyolefin layer would have been advantageous since a polyolefin layer would be cheaper and not require a metal clamp or clip for sealing. This obvious modification would have produced the invention as claimed in claims 1-3, 5, 7-15, 17, 19-25.
9. The limitations recited in claims 1-25 are obvious variations/improvements to the invention recited by Grund. The use of a metallocene catalyst to produce the polyethylene disposed in the inner layer would have also been obvious to one of ordinary skill in the art at the time the invention was made since metallocene catalyzed polyethylenes exhibit lower melting temperatures than Zeigler-Natta catalyzed polymers. This property is advantageous for heat sealing applications. The production of the modified invention of Grund using metallocene catalyzed polyethylene would have produced the invention as claimed in claim 4.
10. The limitations of melting point, density and melt flow index recited in claim 6 are not specifically enumerated by Grund but are properties that would have been obvious to optimize to one of ordinary skill in the art at the time the invention was made.

11. The methods of packaging meat products recited in claims 16 and 18 would have been obvious to one having ordinary skill in the art at the time the invention was made who desired to package meat. It would have also been obvious to one of ordinary skill in the art at the time the invention was made to have produced a bag, food wrap or food package as recited in claims 17 and 20-21 since the tubular film of the invention is specifically recited to be useful for packaging.

Response to Arguments

1. Applicant's arguments filed 5/14/08 have been fully considered but they are not persuasive. Applicants have argued on page 9 of the remarks filed that the instant invention addresses a long-felt and previously unsatisfied need in the food packaging art. However, evidence of this need is not presented. As stated in MPEP 716.01 (a) [R-2] "The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant." Applicant has presented no factual evidence to rebut the *prima facie* case of obviousness set forth in the previous rejection by demonstration of meeting a long-felt and previously unsatisfied need in the food

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packaging art. As such, applicants' arguments on these grounds are not found persuasive.

2. Applicants' comparison of the instant invention with that of Grund in order to show unexpected results is not germane because the properties described by applicant to be unexpected in the instant invention are not reflected in the claims. Applicant has presented no arguments to refute that the obvious modification of Grund motivated by the desire to provide superior heat sealing capabilities to the invention of Grund would not have produced the invention as claimed. Additionally, the evidence presented by applicant to compare the invention of Grund with the instant application recites seal seam strengths, the very property that would be expected to be improved by the modification of Grund to include a superior sealing polyolefin layer.

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., bony meat puncture resistance) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicants have asserted that the patentability of this invention hinges upon its superior resistance to puncture by bony meat products, but no evidence has been presented comparing the resistance to puncture of the instant invention to the invention of Grund. Furthermore, resistance to puncture by bony meat products is not reflected anywhere in the claims and is therefore not germane. As such applicants'

arguments regarding US 6004599 and AU 199938013 are also not germane to the patentability of the pending claims.

4. Applicant states on page 13 of the remarks that they reserve the right to file a Terminal Disclaimer later, if necessary. As such the double patenting rejection over copending application number 10/518542 is upheld.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELE JACOBSON whose telephone number is (571)272-8905. The examiner can normally be reached on Monday-Thursday 8:30 AM-7 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michele L. Jacobson
Examiner /M. J./
Art Unit 1794

/Carol Chaney/
Supervisory Patent Examiner, Art Unit 1794